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REMARKS

Claims 1-20 are pending in the present Application. By this Amendment, Applicant has amended claim 4. Applicant respectfully submits no new matter was added by this Amendment. Accordingly, claims 1-20 are at issue.

A. Oath/Declaration

The Examiner has objected to the Oath/Declaration because the Oath/Declaration claims priority from application 09/927,005 while the disclosure claims priority from application 08/927,005. Applicant submits that the "09" in the Oath/Declaration was a typographical error.

A new Oath/Declaration is submitted to correctly identify applications to which this application claims priority. The support for this designation can be found in the Related Applications section of the specification. Applicant wishes to thank the Examiner for his patience with this section of the application.

B. Rejection Under 35 U.S.C § 112

The Examiner has rejected claim 4 under 35 U.S.C. §112, second paragraph. Applicant has amended claim 4 to overcome the rejection under 35 U.S.C. § 112. No new matter has been added as support for this change is found in the specification. Applicant contends that claim 4 is now in condition for allowance.

C. Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1, 3-9, 11, and 13-19 under 35 U.S.C. §103(a) as being unpatentable over *Gosling*, in view of *Lewis*. Applicant respectfully traverses this rejection.

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Claim 1 of the present Application is directed to a system for programming application programs controlling a programmable logic controller from a communication network. Among other limitations, claim 1 requires "an interface module for coupling the programmable logic controller to the communication network," and a "at least one Web page resident in the programmable logic controller, the Web page linked to the program editor."

Claim 11 of the present Application is similarly directed to a system for programming application programs controlling a programmable logic controller from a communication network. Among other limitations, claim 11 requires "means for coupling the programmable logic controller to the communication network" and "at least one Web page resident in the programmable logic controller, the Web page linked to the creating and editing means resident in the programmable logic controller."

The primary reference relied upon in the Office Action, *Gosling*, fails to disclose the inventions of claims 1 and 11. As an initial point, the Examiner acknowledges "*Gosling* does not specifically disclose a program editor resident in the programmable logic controller, the program editor for creating and editing the application programs." (See Detailed Action, p. 3).

Additionally, *Gosling* fails to disclose or suggest a system using programmable logic controllers as required by claims 1 and 11. Moreover, because there is no disclosure of use of a programmable logic controller, *Gosling* also fails to disclose, among other limitations, "an interface module for coupling the programmable logic controller to the communication network."

The Office Action claims that 110a, 110b, and 110c in Figure 1 are programmable logic controllers. However, a careful review of *Gosling* shows this is not the case. The description of 110a in Figure 1 is a TV Enclosure, 110b is a VCR enclosure, and 110c is a Device enclosure. While there is some reference to a device that is called a controller associated with these enclosures, there is no indication that these controllers are programmable, especially in the manner that a "programmable logic controller" is programmed.

The text in col. 4 lines 24-41 of *Gosling* similarly identifies these elements as "enclosures" for various types of consumer electronics. A programmable logic controller is not

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an enclosure, nor does it have anything to do with consumer or home electronics. Instead, "Programmable logic controllers (PLCs) are widely used in industry and process control" (present application at page 2, lines 1-2). This is an entirely different field from that which *Gosling* describes.

In addition, *Gosling* does not describe a Web page linked to the program editor at col. 7, line 48- col. 8 line 4 as maintained in the Office Action. Instead, *Gosling* describes a file of attribute data of a device. As the Examiner notes, there is no reference to editing here or elsewhere in *Gosling*.

Another difference is that *Gosling* does not describe accessing of a program editor to edit application programs. In col 6, lines 24-39 and col 7, lines 25-41 of *Gosling*, there is a description of sending commands to a device; however, there is no reference to programming, program editors, or application programs. In fact, the only reference to editors in *Gosling* appears at col 1, lines 29-46 where the use of text editors are described to view files on a client. This is exactly the opposite of the present invention where the editor is on the PLC and is used for editing in addition to viewing.

The Office Action then uses *Lewis* in an attempt to find the elements missing from *Gosling*. However, where *Lewis* at col. 15, lines 50-60 and Figures 2 and 8 may disclose some sort of editor, it does not disclose an editor on the PLC. Instead, it teaches away from that concept, stating that the editor is on a separate computer and then the editor downloads the output of the editor ("run time project") to the PLC (col. 2, line 64 through col. 3, line 10).

Furthermore, *Lewis* does not include any teaching of Web pages or the Web. Therefore, there are no references to a Web page associated with a program editor as required by claims 1 and 11.

As set forth above, *Gosling* fails to disclose each of the limitations of claims 1 and 11. *Lewis* does not provide the missing elements. Since the combination of *Gosling* and *Lewis* fail to provide each and every element of the independent claims, a rejection under 35 USC 103 is not proper. Accordingly, Applicant respectfully submits claims 1 and 11 are patentable over *Gosling*

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in view of *Lewis*.

Claims 3-9, and 13-19 depend, either directly or indirectly on claims 1 and 11 respectively, and include each of their limitations. Accordingly, Applicant respectfully submits claims 3-9 and 13-19 are also patentable over *Gosling* in view of *Lewis*.

Moreover, the Office Action has failed to provide a motive or incentive as to why it would have been obvious to combine *Gosling* with *Lewis*. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). When the motivation to combine the teachings of the references is not immediately apparent, an explanation is required as to why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). Applicant respectfully submits that because a suggestion or motivation to combine the cited references has not been shown, a prima facie case of obviousness has not been made. The mere fact that a "program editor would provide a development system that unifies all the configuration information or other data" is not an incentive to combine, nor is it a roadmap to combine the select elements in the manner suggested.

Instead, isolated features from the cited references have been used with the claims of the present application as a template. Such hindsight reconstruction is improper. It is well recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *Fine*, 837 F.2d at 1075 (Stating that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.")

The Office Action fails to meet its initial burden of factually supporting any prima facie conclusion of obviousness. See MPEP § 2142. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

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expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As set forth above, there is no suggestion or motivation in the art to make the proposed combination. Moreover, there is no expectation of success if the references were in fact combined.

The Office Action merely concludes that the combination is obvious and fails to show a teaching or motivation in the prior art to combine features of *Gosling* with *Lewis* in the manner suggested in the rejection. See *In Re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (Confirming that "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). Clear and particular evidence is required to be provided showing why one skilled in the art would combine the references in the manner suggested. *In Re Dembiczak*, 175 F.3d at 999 (Stating that "[t]he range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular."). Instead, the Office Action merely infers as to what the prior art would suggest to one of ordinary skill in the art. Such unsupported inferences regarding teaching or motivation, are insufficient. *In Re Dembiczak*, 175 F.3d at 999 (Providing that "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'").

The Examiner has rejected claims 2, 10, 12 and 20 under 35 U.S.C. 103(a) as being unpatentable over *Gosling* in view of *Lewis* and further in view of *Azarya*. Applicant respectfully traverses this rejection.

As set forth above, Applicant submits claims 1 and 11 are patentable over *Gosling* in view of *Lewis*. *Azarya* does not disclose the limitations not present in *Gosling* or *Lewis*. Moreover, there is no incentive to combine *Azarya* with *Gosling* and *Lewis* in the manner suggested by the Examiner. Furthermore, the provision of "a standard for information to be transfer [sic] between devices faster and more efficiency [sic]" does not suggest that these

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elements be combined with the *Gosling* and *Lewis*.

Claims 2 and 10 depend from claim 1, either directly or indirectly, and claims 12 and 20 depend from claim 11, either directly or indirectly, and include each of their respective limitations. Accordingly, Applicant respectfully submits claims 2, 10, 12 and 20 are also patentable.

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CONCLUSION

In conclusion, applicant submits that claims 1-20 claim matter that is distinct from the prior art and requests that the rejections under 35 U.S.C §§ 103 and 112 be withdrawn.

With the submission of this Amendment, this application is in condition for further examination and early consideration of the claims at issue and early allowance is hereby requested.

Respectfully submitted,



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